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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/630,248  | 07/30/2003  | Xueying Huang        | CL1943USNA          | 9378             |
| 23906   | 7590        | 02/07/2007           | EXAMINER            |                  |
| E I DU PONT DE NEMOURS AND COMPANY<br>LEGAL PATENT RECORDS CENTER<br>BARLEY MILL PLAZA 25/1128<br>4417 LANCASTER PIKE<br>WILMINGTON, DE 19805 |             |                      | LIN, JAMES          |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1762                |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE  | MAIL DATE   | DELIVERY MODE        |                     |                  |
| 3 MONTHS  | 02/07/2007  | PAPER                |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/630,248             | HUANG ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Jimmy Lin              | 1762                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 December 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.  
 4a) Of the above claim(s) 1,3,4,18 and 20-32 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2,5-17 and 19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 5-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton et al. (*Langmuir* 1999, 15, pg. 66-76) in view of Foos et al. (*Chem. Mater.* 2002, 14, pg. 2401-2408).

The rejection is cited in the Office Action filed 7/3/2006. [REDACTED] *Kit 1/07*

***Response to Arguments***

3. Applicant's arguments filed 12/11/2006 have been fully considered but they are not persuasive.

Claims 2, 5-17, and 19 as rejected over Templeton and Foos:

The Applicant argues that the water content in the reaction solvent mixture has to be well-controlled in order to get the product with good yield and that the control of water content was a key finding that had never been disclosed in the prior art. The Applicant further argues that the 2003 JACS paper provides evidence for such unexpected results. However, the claims are not in commensurate in scope with the evidence provided in the 2003 JACS paper. For example, the claims do not require, *inter alia*, the water soluble metallic nanoparticle with a mixed monolayer to be an ethylene glycol protected gold nanoparticles, the water miscible solvent to be methanol, the reducing agent to be NaBH<sub>4</sub>, and the shielding component to be an ethylene glycol. There is no evidence indicating that the water content would show unexpected results for making any nanoparticle or when using any solvent, reducing agent, and shielding component. In addition, the 2003 JACS paper does not even seem to mention the use of a capture coating component when coming to the conclusion of a criticality on the water content. Therefore, the evidence as provided in the 2003 JACS paper does not properly overcome the

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rejections of Templeton and Foos because the claims are not commensurate in scope with the present claims.

The Applicant argues that a 131 Declaration signed by Ming Zheng swears behind the online publication date of Foos and that the claimed invention is nonobvious over Templeton with the removal of Foos as a reference. In the 131 Declaration, Ming Zheng refers to Exhibits 1 and 2 as evidence of reduction to practice. However, Exhibits 1 and 2 cannot be found in the response submitted 12/11/2006 and have not been considered for obvious reasons. Without such evidence, the Applicant can not overcome the Foos reference. The rejection has therefore been maintained.

### *Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Lin whose telephone number is 571-272-8902. The examiner can normally be reached on Monday thru Friday 8AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL



KEITH HENDRICKS  
PRIMARY EXAMINER